

**R E M A R K S**

- Claims 1-29 are pending in the present application.
- Claims 4-8 have been cancelled
- Claims 1, 13, 17, 23, and 27-29 are independent.

Claim 5 has been cancelled and the limitations of the claim incorporated into the body of Independent Claims 1 and 17.

Independent Claim 29 is newly added, support for which can be found in the specification, for example, at page 13, lines 22-24 and page 23, lines 16-25. No new matter has been added.

**I. Section 101 Rejection**

Claims 1-16 and 28 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. [Current Office Action, page 2]. While Applicants disagree with the Examiner's rejection of the claims, Applicants have amended independent Claims 1 and 28 to "utilize the vending machine" as suggested by the Examiner [Current Office Action, page 5] to expedite prosecution of the instant claims. Accordingly, Applicants respectfully request reconsideration and withdrawal of the instant Section 101 rejection.

Applicants intend to seek claims in subsequent continuing applications directed to the original subject matter and pursue the instant claims without prejudice or disclaimer.

**II. Double Patenting Rejection**

All of pending Claims 1-28 stand "rejected under the judicially created doctrine of obviousness-type double patenting" as being unpatentable over unspecified claims of U.S. Application No. 09/218,085, U.S. Application No. 09/540,709, U.S. Application No. 09/994,810, U.S. Application No. 09/688,372, and U.S. Application No. 09/713,001.

While we do not agree with this rejection, the provisional double patenting rejection of Claims 1-28 is moot since none of the claims have been issued.

**III. Section 103(a) Rejection**

Claims 1-28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,115,649 issued to Sakata ("Sakata"), in view of U.S. Patent No. 4,717,043 issued to Groover, et al. ("Groover") and further in view of U.S. Patent No. 5,687,322 issued to Deaton et al. ("Deaton"). We respectfully traverse the Examiner's Section 103(a) rejection. . The record does not provide a sufficient basis for a prima facie showing of obviousness.

**1. Factual Inquiries Required by *Graham* for Determination of Obviousness Under 35 U.S.C. § 103**

In Graham v. John Deere Co., 383 U.S. 1, 148 U.S.P.Q. 459 (1966), the Supreme Court established the test for consideration and determination of obviousness under 35 U.S.C. § 103. U.S. Patent and Trademark Office policy is to follow Graham. Accordingly, examiners should apply the test for patentability under 35 U.S.C. § 103 as set forth in Graham. M.P.E.P. § 2141 (8<sup>th</sup> ed. (Rev. 2), May 2004), p. 2100-120.

The four factual inquiries enunciated in Graham as a background for determining obviousness of a claim are as follows:

- a) Resolving the level of ordinary skill in the pertinent art;
- b) Determining the scope and contents of the prior art;
- c) Ascertaining the differences between the prior art and the claims in issue;  
and
- d) Evaluating evidence of secondary considerations.

M.P.E.P. § 2141. Some of these factual inquiries are discussed briefly below and, as discussed, the Examiner has failed to even make the required factual inquiries.

**(a) Level of Ordinary Skill in the Art**

Ascertaining a level of ordinary skill in the art is necessary. M.P.E.P. § 2141.03. See Ryko Mfg. Co. v. Nu-Star, Inc., 950 F.2d 714, 718 (Fed. Cir. 1991) ("Hence, the level of ordinary skill in the art is a factual question that must be resolved and considered."). Some factors that may be considered are outlined at M.P.E.P. § 2141.03.

Without a factual determination of the level of ordinary skill in the art, obviousness cannot be assessed properly because the critical question is whether a claimed invention would have been obvious at the time it was made to one with ordinary skill in the art. Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc., 807 F.2d 955, 962 (Fed. Cir. 1986).

Thus, a determination of the level of ordinary skill in the art is an integral part of the Graham analysis. Ruiz v. A.B. Chance Co., 234 F.3d 654, 666 (Fed. Cir. 2000) (citing Custom Accessories, 807 F.2d at 962).

**(b) Scope and Content of the Prior Art**

To rely on a reference under 35 U.S.C. § 103, the reference must be analogous prior art. M.P.E.P. § 2141.01(a). Also, in order to avoid impermissible hindsight, the content of the prior art must be determined as of the time the invention was made. M.P.E.P. § 2141.01. The findings of the scope of the prior art, like all factual findings, must be supported by substantial evidence. In re Gartside, 203 F.3d 1305, 1316, 53 USPQ2d 1769, 1776 (Fed. Cir. 2000).

**(c) Differences between the Prior Art and the Claims**

Ascertaining the differences between the prior art and the claims at issue requires (i) interpreting the claim language, and (ii) considering both the invention and the prior art references as a whole. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. M.P.E.P. § 2141.02 (emphasis in original).

**2. Prima Facie Case of Obviousness**

In view of all factual information, the Examiner must then make a determination whether the claimed invention “as a whole” would have been obvious to the hypothetical “person of ordinary skill in the art” when the invention was unknown and just before it was made. M.P.E.P. § 2142.

**(a) Basic Requirements**

To establish a *prima facie* case of obviousness for a claim, three basic criteria must be met:

1. There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art;
2. There must be some reasonable expectation of success; and
3. The prior art reference (or references when combined) must teach or suggest all the claim limitations.

See M.P.E.P. § 2143.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. § 2143.01. “Recognition of a need does not render obvious the achievement that meets that need. There is an important distinction between the general motivation to cure an uncured disease (for example, the disease of multiple forms of heart irregularity), and the motivation to create a particular cure.” Cardiac Pacemakers v. St. Jude Medical, 381 F.3d 1371, 1377 (Fed. Cir. 2004).

**(b) The Examiner Bears the Initial Burden of Factual Support**

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. M.P.E.P. § 2142. The initial burden, therefore, is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. M.P.E.P. § 2142.

**3. The Examiner has Failed to Conduct the Required *Graham* Inquiries**

We have carefully reviewed the Section 103 rejections of Claims 1-28 in the present Office Action to determine compliance with the Graham requirements. We respectfully submit that the Examiner has not followed Graham with respect to any rejection under Section 103.

Specifically, the Examiner has neither

- (i) defined a level of ordinary skill in the art, nor

- (ii) clearly indicated any evidence in support of his "finding" of the level of skill.

Such findings are necessary in assessing obviousness. M.P.E.P. § 2141.03.

As a result of the failure to resolve and consider the level of ordinary skill, the Examiner (i) cannot have determined the scope and content of the prior art objectively, i.e., from the point of view of the hypothetical person having ordinary skill in the art at the time of invention, and thus (ii) cannot have determined the differences between the cited references and the claims objectively.

"[I]t is reversible error if the required factual determinations are not actually made or it is not clear that the required factual determinations were considered while applying the proper legal standard of obviousness" *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 990 (Fed. Cir. 1988).

The evidence of record indicates that the level of skill is in fact low. For example, no reference of record even addresses the problem to be solved by the present invention, much less any generalities of the solutions provided by the present invention.

As the Examiner has failed to conduct the required Graham factual inquiries, the Examiner cannot factually support any *prima facie* conclusion of obviousness with respect to any pending claim.

#### **4. Request for Factual Support**

In any subsequent Office Action asserting a Section 103 rejection, we respectfully request that the Examiner clearly indicate, with respect to each rejected claim, the support in the record for any findings under the required Graham factual inquiries: (i) the level of ordinary skill in the pertinent art; (ii) the scope and contents of the prior art; (iii) the differences between the prior art and the claims in issue; and (iv) any evidence of secondary considerations.

In particular, we respectfully request that the Examiner define and submit evidence of the level of ordinary skill. Some factors that may be considered in determining the ordinary level of skill in the art are outlined at M.P.E.P. § 2141.03.

**5. The Examiner has Failed to Meet the Basic Criteria for *Prima Facie* Obviousness**

The Examiner has failed to make the requisite factual findings required under Graham (outlined above) and thus cannot factually support a *prima facie* conclusion of obviousness with respect to any claim.

For example, without resolving the level of ordinary skill in the art, the Examiner has no factual support for an assertion that either (a) a claimed feature or (b) a motivation to combine / modify references may be found objectively either (i) in the references themselves, (ii) in the knowledge generally available to one of ordinary skill in the art, or (iii) in the nature of the problem to be solved.

In addition, the Examiner has failed to make any assertion of a reasonable expectation of success with respect to any claim.

For at least these reasons, we respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness for any pending claim.

Some criteria that have not been met with respect to particular claims are discussed further herein.

**6. Independent Claims 1 and 17**

We respectfully submit that independent Claims 1 and 17 are not obvious in light of Sakata, Groover or Deaton, either alone or in combination. First, no combination of Sakata, Groover or Deaton teaches or suggests all of the features of independent Claims 1 and 17.

Second, there is no suggestion or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art, to modify or to combine the cited references to provide for all of the claimed features of independent Claims 1 and 17.

**(a) The References Do Not Disclose All the Limitations of Independent Claims 1 and 17**

Claims 1 and 17 have been amended to generally include limitations directed to:

- *identifying a state of a service queue at a retail establishment*

- *outputting a coupon that is redeemable at the retail establishment to the customer at the vending machine, in response to the received request, based on the identified state of a service queue at the retail establishment*

Applicants assert that no combination of the cited references teach or suggest at least the above limitations.

As best understood by us, the Examiner asserts the following to be true with respect to independent Claims 1 and 17:

Sakata discloses:

- outputting an offer to the customer in response to the received request  
[Current Office Action, page 6]

Deaton discloses:

- Coupons can be presented to a user based on conditions at a retail store  
[Current Office Action, page 7]
- minimizing the time in a queue and that customers do not like to be in long queue [Current Office Action, page 8]
- customer can be deemed valuable and presented with coupons in different manners dependent upon how valuable that customer is deemed to be [Id.]

We respectfully traverse these assertions as unsupported by the record. We have carefully reviewed the Sakata and Deaton references cited by the Examiner, without finding a teaching or suggestion of *identifying a state of a service queue at a retail establishment*, much less *outputting a coupon that is redeemable at the retail establishment to the customer at the vending machine, in response to the received request, based on the identified state of a service queue at the retail establishment*.

In contrast, and contrary to the Examiner's assertion, Sakata is devoid of any teaching of *outputting a coupon that is redeemable at the retail establishment to the customer at the vending machine, in response to the received request, based on the*

*identified state of a service queue at the retail establishment*, as generally recited in independent Claims 1 and 17. The cited portion of Sakata describes:

Upon receiving data showing the selected toy from the touch panel 4, the control unit 15 instructs the communication interface 13 to transmit the data to the host computer (S020). FIG. 11 is a conceptual drawing showing a situation where an image of merchandise and contents of a questionnaire are sent from a manufacturer and a distributor to the vending machine 1, a situation where an answer to the questionnaire is transferred to the manufacturer and the distributor, and a situation where a consideration to be made for answer to the questionnaire is given by the manufacturer and the distributor.

[Column 10, lines 10-22]. Sakata thus describes a system in which consideration to a customer is made in exchange for answering a questionnaire. There is nothing in Sakata that teaches or suggests outputting a coupon redeemable at a retail establishment based upon the state of the service queue at that retail establishment. Therefore, there is nothing in Sakata that would suggest *outputting a coupon that is redeemable at the retail establishment based on the identified state of a service queue at the retail establishment*.

In addition, we respectfully traverse the Examiner's assertion that Deaton discloses *identifying a state of a service queue at a retail establishment or outputting a coupon that is redeemable at the retail establishment to the customer at the vending machine, in response to the received request, based on the identified state of a service queue at the retail establishment*. The Examiner does not assert that Sakata discloses either of the above features.

Specifically, the Examiner states that Deaton discloses “minimizing the time in a queue and that customers do not like to be in long queues” [Current Office Action, page 8], that “customers can be deemed valuable and presented with coupons in different manners dependent upon how valuable that customer is deemed to be” [Id.] and that “the coupon can be given on a variety of conditions.” [Id.]. The cited sections of the reference disclose 1) the problems with collecting customer information due to the emphasis on minimizing the amount of time required for a sales transaction, 2) providing coupon packs to customers with different purchasing histories, and 3) the ability to customize incentives to drive purchasing behavior according to shopping visit criteria, product group, department or individual products. Nothing in the cited portions of the reference



or the reference as a whole even hint at *identifying a state of a service queue at a retail establishment* much less *outputting a coupon that is redeemable at the retail establishment in response to the received request, based on the identified state of a service queue at the retail establishment*.

We have carefully reviewed both the Sakata and Deaton references cited by the Examiner, without finding a teaching or suggestion of either of the above features. Specifically, as neither Sakata nor Deaton, alone or in combination, teaches or suggests *identifying a state of a service queue at a retail establishment* nor *outputting a coupon that is redeemable at the retail establishment to the customer at the vending machine, in response to the received request, based on the identified state of a service queue at the retail establishment* as generally recited in independent Claims 1 and 17. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of independent Claims 1 and 17.

If, on the other hand, our understanding as to what the Examiner is asserting with respect to independent Claims 1 and 17 is incorrect, we request clarification of the Examiner's position so that the present application may proceed to allowance or appeal.

**(b) No Motivation to Combine the Cited References**

As best understood by us, the Examiner also asserts the following to be true with respect to independent Claims 1 and 17:

- It would have been obvious to one of ordinary skill in the art to modify Sakata in light of Deaton to provide for a feature of *coupon offered to the user can be based on a condition at a retail establishment and providing a coupon based upon the state of the service queue at the retail establishment* [Current Office Action, pp 7, 8]
- The motivations for this modification in above would be 1) in order to entice the user to purchase the products available at a store and 2) to make offers to the customer that will keep the customer more satisfied. [Current Office Action, pp 7, 8].

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 706.02(j). In re Fine, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 21 USPQ2d 1941 (Fed. Cir. 1992).

In view of the above, the Examiner must show that the prior art of record provides the motivation of (b) above. MPEP 2143. Further, the Examiner must show that the asserted subject matter of (b) above includes a teaching, suggestion, or motivation to make the proposed combination or modification of the asserted teachings of the prior art to produce the specific features of the claimed invention.

**(i) The Asserted Motivation is Not Shown in the Cited References**

We have carefully reviewed the Office Action issued in the present application, as well as the Sakata and Deaton references cited by the Examiner, without finding a motivation anywhere in the record that suggests the desirability of combining or modifying the cited references in the manner proposed by the Examiner.

The Examiner does not assert otherwise. The Examiner's statement thus amounts to no more than a conclusory statement of a generalized advantage (a "to entice the users to purchase products available at a store" and "keep the customer more satisfied") and an unsupported allegation about what was known to those of ordinary skill.

**(ii) The Asserted Motivation Does Not Suggest the Desirability of *coupon offered to the user can be based on a condition at a retail establishment or providing a coupon based upon the state of the service queue at the retail establishment***

Further, the motivation as asserted by the Examiner, would not suggest the desirability of modifying the vending system of Sakata to provide specifically for the feature of *coupon offered to the user can be based on a condition at a retail establishment*, much less *providing a coupon based upon the state of the service queue at the retail establishment* as generally recited in independent Claims 1 and 17. The

Examiner does not provide any reasoning or support in the evidence of record as to why the asserted desirability of enticing users to purchase the products available at a store and making offers to the customer that will keep the customer more satisfied, would specifically suggest to one of ordinary skill in the art the desirability of provide for *coupon offered to the user can be based on a condition at a retail establishment or providing a coupon based upon the state of the service queue at the retail establishment* in the Sakata system to meet any of the asserted desirable objectives.

Accordingly, the asserted motivation in Deaton reference amounts to a mere statement by the Examiner that the proposed combination or modification would be advantageous. This statement does not meet the requirement of evidence of a motivation in the prior art to combine the particular asserted teachings in the manner proposed by the Examiner. We respectfully submit that the purported motivations do not suggest any such modification of the Sakata system.

Also, the asserted motivation enticing users to purchase the products available at a store suggests neither the desirability of *coupons offered to the user can be based on a condition at a retail establishment* much less a motivation for modifying the system of Sakata. In fact, Deaton describes varying coupon incentives to motivate both infrequent and frequent shoppers to re-patronize a store. [Column 67, lines 5-12.] It is not clear to us how Deaton's description of varying coupon incentives to motivate both infrequent and frequent shoppers to re-patronize a store suggests either a motivation to provide for *coupons offered to the user can be based on a condition at a retail establishment* or a motivation to modify the system of Sakata; we respectfully request clarification of the Examiner's reasoning.

We respectfully submit that there is no suggestion in the prior art of record to combine the particular asserted teachings of the prior art to provide for all of the features of independent Claims 1 and 17. Accordingly, we respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness of independent Claims 1 and 17.

If, on the other hand, our understanding of what the Examiner is asserting to be true is incorrect, we request clarification of the above so that the present application may proceed to allowance or appeal.

For at least the reasons stated herein, we respectfully request allowance of the pending Claims 1 and 17.

**7. Dependent Claims 2-4, 9-12 and 18-22**

Dependent claims 2-4, 9-12 and 18-22 are dependent upon independent Claims 1 and 17 discussed above. As claims 2-4, 9-12 and 18-22 incorporate the limitations of the respective independent claims above by reference, claims 2-4, 9-12 and 18-22 are allowable at least for the same reasons discussed above.

**8. Independent Claim 13**

We respectfully submit that independent Claim 13 is not obvious in light of Sakata, Groover or Deaton, either alone or in combination. First, no combination of Sakata, Groover or Deaton teaches or suggests all of the features of independent Claim 13.

Second, there is no suggestion or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art, to modify or to combine the cited references to provide for all of the claimed features of independent Claim 1.

**(a) The References Do Not Disclose All the Limitations of Independent Claim 13**

Claim 13 has been amended to generally include limitations directed to:

- *determining whether the item can be dispensed by the vending machine*
- *if it is determined that item cannot be dispensed by the vending machine, outputting to the customer a coupon for the item to be redeemed at a retail establishment*

Applicants assert that no combination of the cited references teach or suggest at least the above limitations.

As best understood by us, the Examiner asserts the following to be true with respect to independent Claim 13:

Sakata discloses:

- determining whether the requested transaction can be performed by the vending machine [Current Office Action, page 6]
- if it is determined that the requested transaction cannot be performed by the vending machine, outputting an offer to the customer in response to the received request [Current Office Action, page 7]

We respectfully traverse these assertions. We have carefully reviewed the Sakata without finding a teaching or suggestion of *determining whether the item can be dispensed by the vending machine*, much less *if it is determined that item cannot be dispensed by the vending machine, outputting to the customer a coupon for the item to be redeemed at a retail establishment*.

In contrast, and contrary to the Examiner's assertion, Sakata is devoid of any teaching of *determining whether the item can be dispensed by the vending machine*, as generally recited in independent Claim 13. The cited portions of Sakata describes:

Furthermore, with a conventional vending machine system, when a customer finds a merchandise he/she wishes to purchase is out of stock, he/she cannot get information on where a transportation vehicle for supplementing th [sic] merchandise runs.

[Column 1, lines 54-64]

Upon receiving data showing the selected toy from the touch panel 4, the control unit 15 instructs the communication interface 13 to transmit the data to the host computer (S020). FIG. 11 is a conceptual drawing showing a situation where an image of merchandise and contents of a questionnaire are sent from a manufacturer and a distributor to the vending machine 1, a situation where an answer to the questionnaire is transferred to the manufacturer and the distributor, and a situation where a consideration to be made for answer to the questionnaire is given by the manufacturer and the distributor.

[Column 10, lines 10-22]

Sakata thus describes a system where a customer can see the location of a transportation vehicle for supplementing the contents of a vending machine and in which consideration to a customer is made in exchange for answering a questionnaire. There is

nothing in Sakata that teaches or suggests outputting a coupon to be redeemed at a retail establishment for the item that could not be dispensed. Therefore, there is nothing in Sakata that would suggest *if it is determined that item cannot be dispensed by the vending machine, outputting to the customer a coupon for the item to be redeemed at a retail establishment.*

We have carefully reviewed both the Sakata, Groover and Deaton references cited by the Examiner, without finding a teaching or suggestion of either of the above features. Specifically, none of the references, alone or in combination, teaches or suggests *determining whether the item can be dispensed by the vending machine much less if it is determined that item cannot be dispensed by the vending machine, outputting to the customer a coupon for the item to be redeemed at a retail establishment* as generally recited in independent Claim 13. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of independent Claim 13.

If, on the other hand, our understanding as to what the Examiner is asserting with respect to independent Claim 13 is incorrect, we request clarification of the Examiner's position so that the present application may proceed to allowance or appeal.

**(b) No Motivation to Combine the Cited References**

Applicants assert that the Examiner has failed to provide any motivation to combine the references, let alone a proper motivation to combine the references with respect to Claim 13. As such, for the same reasons discussed above with respect to Claims 1 and 17, the Examiner has therefore failed to establish a *prima facie* case of obviousness for at least the reasons discussed above.

Additionally, Applicants assert that the Examiner has failed to establish a *prima facie* case of obviousness with respect to Claim 13 for the following reasons.

**1. The Cited Portions of the Reference Cannot be Combined to Arrive at the Limitations of the Claim**

The Examiner has attempted to combine portions of Sakata that cannot be combined nor has the Examiner provided a motivation to combine the references in the manner suggested to arrive at the limitations of Claim 13.

The Examiner has failed to provide on the record any motivation to combine the references in the manner suggested. The first portion of Sakata cited (Column 1, lines 54-64) refers to tracking the location of a vending supply truck, whereas the second portion (Column 10, lines 10-22) refers to compensating customers for answering a questionnaire. Applicants assert that these disparate concepts cannot be combined to arrive at the limitations of the instant claim, nor can they be combined at all. The Examiner does not assert otherwise.

Further, even if the Examiner has provided a proper motivation to combine the cited portions of the reference discussed above, the combination fails to teach the limitations of Claim 13. The Examiner has cited portions of the reference that arguably teach 1) determining if an item may be purchased from a vending machine and 2) providing consideration for completing a questionnaire.

However, the Examiner has effectively read the word “if” out of the claim. No portion of Sakata, nor any portion of Groover or Deaton teach or suggest outputting a coupon for an item in response to determining a failure to dispense the item. Therefore, the combination of the portions of Sakata cannot teach *determining whether an item can be dispensed by the vending machine and if the item cannot be dispensed, outputting to the customer a coupon to be redeemed at a retail establishment for the same item that cannot be dispensed*. Consequently, the Examiner has failed to provide a proper motivation to combine the references in the manner suggested and has therefore failed to establish a *prima facie* case of obviousness under Section 103 for at least these reasons.

#### **9. Dependent Claims 14-16**

Dependent claims 14-16 are dependent upon independent Claim 13 discussed above. As claims 14-16 incorporate the limitations of the respective independent claim above by reference, claims 14-16 are allowable at least for the same reasons discussed above.

**10. Independent Claims 23 and 28**

We respectfully submit that independent Claims 23 and 28 are not obvious in light of Sakata, Groover or Deaton, either alone or in combination. First, no combination of Sakata, Groover or Deaton teaches or suggests all of the features of independent Claims 23 and 28.

Second, there is no suggestion or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art, to modify or to combine the cited references to provide for all of the claimed features of independent Claim 23 and 28.

**(a) The References Do Not Disclose All the Limitations of Independent Claims 23 and 28**

Claims 23 and 28 have been amended to generally include limitations directed to:

- *detection means that are located at a retail establishment for detecting whether a predetermined condition exists at the retail establishment*
- *offer means for selectively outputting a coupon, the offer means selective upon the detection of the predetermined condition*

Applicants assert that no combination of the cited references teach or suggest at least the above limitations.

The Examiner has failed to indicate which portion of the references of record the Examiner feels teach the above limitations. As best understood by us, the Examiner asserts the following to be true with respect to independent Claims 23 and 28:

Deaton discloses:

- Coupons can be presented to a user based on conditions at a retail store  
[Current Office Action, page 7]

We respectfully traverse these assertions. We have carefully reviewed the Deaton reference cited by the Examiner, without finding a teaching or suggestion of *detection means that are located at a retail establishment for detecting whether a predetermined*



*condition exists at the retail establishment, much less offer means for selectively outputting a coupon, the offer means selective upon the detection of the predetermined condition.*

The cited portion of Deaton describes:

Recognizing that every group of customers, and in fact, every individual customer has different valuations of an incentive, and depending on whether or not a store has the product or whether the store is short of on inventory a product, the incentive may be changed.

[Column 103, lines 6-10].

Deaton arguably describes a system in which incentives may be changed in response to customer response to the incentive or whether the store is short of on inventory a product. There is nothing in Deaton that teaches or suggests detecting whether a predetermined condition exists at a retail establishment and outputting a coupon to a customer at a vending machine in response to the detection of the predetermined condition at the retail establishment. Therefore, there is nothing in Deaton that would suggest *detection means that are located at a retail establishment for detecting whether a predetermined condition exists at the retail establishment much less offer means for selectively outputting a coupon, the offer means selective upon the detection of the predetermined condition* as generally recited in independent Claims 23 and 28. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of independent Claims 1 and 17.

If, on the other hand, our understanding as to what the Examiner is asserting with respect to independent Claims 23 and 28 is incorrect, we request clarification of the Examiner's position so that the present application may proceed to allowance or appeal.

**(b) No Motivation to Combine the Cited References**

Applicants assert that the Examiner has failed to provide any motivation to combine the references, let alone provide a proper motivation to combine the references with respect to Claims 23 and 28. As such, for the same reasons discussed above with respect to Claims 1, 13 and 17, the Examiner has failed to establish a *prima facie* case of obviousness for at least the reasons discussed above.

For at least the reasons stated herein, we respectfully request allowance of the pending Claims **23** and **28**.

#### **11. Dependent Claims 24-26**

Dependent claims **24-26** are dependent upon independent Claim **23** discussed above. As claims **24-26** incorporate the limitations of the respective independent claim above by reference, claims **24-26** are allowable at least for the same reasons discussed above.

Additionally, Applicants assert that the Examiner has failed to establish a *prima facie* case of obviousness with respect to dependent claims **25** and **26** for the following reasons.

Specifically, the Examiner states, with respect to Claim **25**, that Sakata discloses “that said vending machine is installed outside said retail establishment” referring Applicants’ attention to Sakata Figure 12. [Current Office Action, page 10]. As well, the Examiner states, with respect to Claim **26**, that Sakata discloses “that said vending machine is located remotely from said retail establishment” again referring Applicants’ attention to Sakata Figure 12. [Id.].

Having carefully reviewed the Sakata reference, including the accompanying figures, Applicants are confused by the Examiner’s arguments that the same figure (Figure 12) can disclose both a vending machine “installed outside said retail establishment” **and** a vending machine “located remotely from said retail establishment.” Applicants respectfully request clarification.

#### **12. Independent Claim 27**

We respectfully submit that independent Claim **27** is not obvious in light of Sakata, Groover or Deaton, either alone or in combination. First, no combination of Sakata, Groover or Deaton teaches or suggests all of the features of independent Claim **27**.

Second, there is no suggestion or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art, to modify or to combine the cited references to provide for all of the claimed features of independent Claim 27.

**(a) The References Do Not Disclose All the Limitations of  
Independent Claim 27**

Claim 27 has been amended to generally include limitations directed to:

- *trigger means for generating a signal at a retail establishment*
- *offer means for selectively outputting a coupon*
- *said offer means being responsive to said signal by outputting a coupon redeemable at the retail establishment upon the vending machine receiving a transaction request*

Applicants assert that no combination of the cited references teach or suggest at least the above limitations.

As best understood by us, the Examiner asserts the following to be true with respect to independent Claim 27:

Sakata discloses:

- utilization of a trigger signal (Referring to Figures 3a, 11 and 12)[Current Office Action, page 7]
- Sakata's Manufacturer/Distributor is functionally equivalent to a Retailer and that the Host Computer can obviously be located at the Manufacturer/Distributor [Id.]

We respectfully traverse these assertions. We have carefully reviewed the Sakata references cited by the Examiner, without finding a teaching or suggestion of *trigger means for generating a signal at a retail establishment*, much less *offer means being responsive to said signal by outputting a coupon redeemable at the retail establishment upon the vending machine receiving a transaction request*.

In contrast, and contrary to the Examiner's assertion, Sakata is devoid of any teaching of *trigger means for generating a signal at a retail establishment*, as generally recited in independent Claim 27. The portions of Sakata describing the cited figures state:

The communication interface 13 (see FIG. 3a) is a device for transmitting and receiving data via a host computer 20 and a communication line C. The communication interface 13 corresponds to a merchandise data transmitting means 13a, a questionnaire answer data transmitting means 13b, a merchandise image data receiving means 13c, a questionnaire receiving means 13d and a running position data receiving means 13e.

[Column 7, lines 50-57]

FIG. 11 is a conceptual drawing showing a situation where an image of merchandise and contents of a questionnaire are sent from a manufacturer and a distributor to the vending machine 1, a situation where an answer to the questionnaire is transferred to the manufacturer and the distributor, and a situation where a consideration to be made for answer to the questionnaire is given by the manufacturer and the distributor.

[Column 10, lines 15-22]

FIG. 12 is a pictorial view showing a situation where running position data of a transportation vehicle is transmitted to the vending machine 1 via the host computer. A position of a transportation vehicle may be displayed on a map provided in advance.

[Column 10, lines 47-51].

Sakata arguably describes a system in which 1) a host computer in bi-directional communication with a vending machine, 2) transmitting merchandise and questionnaire data to a vending machine and providing consideration for answering the questionnaire and 3) transmitting running position data of a transportation vehicle to the vending machine. There is nothing in Sakata that teaches or suggests *trigger means for generating a signal at a retail establishment and outputting a coupon redeemable at the retail establishment in response to the signal generated at the retail establishment*. Therefore, there is nothing in Sakata that would suggest *offer means being responsive to said signal by outputting a coupon redeemable at the retail establishment upon the vending machine receiving a transaction request*.

Consequently, and contrary to the Examiner's assertion, as Sakata fails to teach *trigger means for generating a signal at a retail establishment* Sakata's Manufacturer/Distributor **cannot** be functionally equivalent to a Retailer as generally recited in Claim 27.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of independent Claim 27.

If, on the other hand, our understanding as to what the Examiner is asserting with respect to independent Claim 27 is incorrect, we request clarification of the Examiner's position so that the present application may proceed to allowance or appeal.

**(b) No Motivation to Combine the Cited References**

Applicants assert that the Examiner has failed to provide any motivation to combine the references, let alone provide a proper motivation to combine the references with respect to Claim 27. As such, for the same reasons discussed above with respect to Claims 1, 13, 17, 23 and 28, the Examiner has failed to establish a *prima facie* case of obviousness for at least the reasons discussed above.

For at least the reasons stated herein, we respectfully request allowance of the pending Claim 27.

**13. New Independent Claim 29**

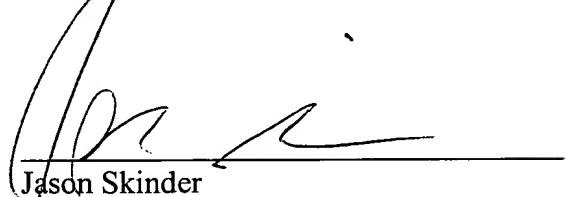
Applicants have added new independent Claim 29. Applicants assert that the limitations of the claim are neither taught nor suggested by the references of record. As such, Applicants respectfully request early consideration and allowance of Claim 29.

**CONCLUSION**

It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Jason Skinder at telephone number 203-461-7017 or via electronic mail at [jskinder@walkerdigital.com](mailto:jskinder@walkerdigital.com).

Respectfully submitted,



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Date